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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,056	04/03/2002	Arno Lange	220950USOPCT	6861
22850 7590 11/12/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER TOOMER, CEPHIA D	
			ART UNIT	PAPER NUMBER
			1771	
			NOTIFICATION DATE	DELIVERY MODE
			11/12/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/089,056	<b>Applicant(s)</b> LANGE ET AL.	
	<b>Examiner</b> Cephia D. Toomer	<b>Art Unit</b> 1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 93-122 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 93-122 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 30, 2010 has been entered.

This Office action is in response to the amendment filed response filed July 30, 2010 in which claims 111-122 were added.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 93-122 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17-32 of copending Application No. 12/110777. Although the conflicting claims are not identical, they are not patentably distinct from each other because the base claims of the present application are more specify as it relates to the amine and the polyisobutene. However, the species of these compounds are definitely encompasses by the broad claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 95 , 103, 111 and 118 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 95 and 111 are rejected because it is not clear why the language for R<sup>6</sup> – “other than H” or the proviso that “R<sup>4</sup> and R<sup>5</sup> are not simultaneously H” is needed. The limitations for these R substituents do not recite that they may be H.

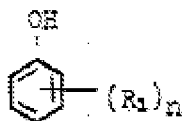
### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 93-96 and 99-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Worrel (US 3,948,619) in view of Cherpeck (US 5,300,701) and Baxter (US 6,562,913).

Worrel teaches a fuel composition comprising gasoline and a detergent amount of the condensation product of an alkylphenol of the formula



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wherein  $n$  is an integer from 1 to 2 and  $R_1$  is an aliphatic hydrocarbon radical having a molecular weight of from about 400 to 1500, from 1-5 mole parts of an aldehyde and 0.5-5 moles of an amine having at least one HN<group (see abstract; col. 1, lines 35-63).

The preferred aliphatic hydrocarbon radical of the phenol is a polybutene (see col. 5, lines 24-36). This teaching suggests polyisobutyl radicals. The aldehyde may be formaldehyde and the amine may be dialkylamines such as dimethylamine or diethylamine (see col. 5, lines 37-47, 59-64). The alkylation of the phenol is carried out in the presence of an alkylation catalyst (see Example 1). The condensation products may be prepared as a concentrate wherein the detergent is present in an amount from 0.1-90 wt % (see col. 22, lines 34-40). The fuel composition may contain other conventional additives (see col. 23, lines 5-26). Worrel also teaches that these condensation products are known lubricant additives (see col. 1, lines 23-32). Worrel teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Worrel differs from the claims in that he does not specifically teach that the alkyl group is a highly reactive PIB having a polydispersity of less than 3.0. However, Cherpeck and Baxter teach these differences.

Cherpeck teaches a process for the preparation of a PIB substituted phenolic compound wherein the phenolic compound is alkylated in the presence of an acid catalyst (see abstract). The PIB has a number average molecular weight of 300-5000 and contains at least about 70% methylvinylidene groups (highly reactive) (see col. 2,

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lines 37- 49). Cherpeck teaches that these PIB compounds are the commercial product ULTRAVIS-10 (molecular weight 950) (see Example 1).

Baxter teaches that highly reactive PIB such as ULTRAVIS possess a polydispersity of no more than 2.0 (see col. 4, lines 12-29, 54-58).

It would have been obvious to one of ordinary skill in the art to have replaced the polybutene of Worrel with a highly reactive polybutene possessing a polydispersity of less than 3.0 because Cherpeck teaches that employing such a polybutene provides the desired PIB-phenol in significantly higher yield than employing conventional PIB having minor amounts of methylvinylidene and the phenols exhibit minimal molecular weight degradation (see col. 4, lines 19-57).

In the second aspect, Worrel differs from the claims in that he does not specifically teach the adduct mixture of claims 95, 96, 99-102, 111, 113, 115 and 116. However, no unobviousness is seen in this difference because Worrel, Cherpeck and Baxter teach a PIB-substituted phenol that appears to meet the claimed limitations and they teach the same amine and aldehyde reactants. Worrel reacts the components in the same manner as Applicant. Therefore, it would be reasonable to expect that the adducts of the present claims would be within the scope of Worrel in view of Cherpeck and Baxter, absent evidence to the contrary.

3. Applicant's arguments filed July 30, 2010 have been fully considered but they are not persuasive.

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4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Cherpeck teaches that upon reading Worrel that the skilled artisan would recognize that the alkylated phenol of Worrel could be alkylated with a highly reactive polyisobutene because a higher yield of the compound would be obtained.

Worrel teaches that the preferred olefins include those having from about 2 to about 10 carbon atoms and he lists butylene as one of those olefins used to prepare the polyolefin (see col. 5, lines 24-31). Cherpeck teaches that polyalkylphenols prepared with the use of polybutene without terminal ethylene units undergo molecular weight degradation. Cherpeck further teaches that his process with the use of highly reactive polyisobutene minimizes or eliminates this problem (see col. 1, line 61 through col. 2, lines 1-17). It is clear that the polybutene of Worrel and the polyisobutene of Cherpeck are not equivalent, but from the standpoint of Worrel, for his intended purpose, all C2-C10 olefins used to prepare the polyolefins of the alkylated phenols are equivalent. Cherpeck provides the motivation to replace the inferior polyolefin of Worrel with one that produces higher yield of the polyolefin-substituted phenol.



Applicant argues that Baxter and Cherpeck do not describe the presently claimed invention even though these patents had the benefit of the passage of almost 20 years since the publication of the Worrel reference. Applicant argues that this temporal relationship between the disclosures of the cited references is probative of the nonobviousness of the presently claimed invention.

Baxter is directed to a process for producing high vinylidene polyisobutylene. Cherpeck is directed to a process for the preparation of polyisobutyl hydroxyaromatics containing high vinylidene polyisobutylene. Neither reference is directed to the detergent of the condensation product of a high molecular weight alkylphenol, an aldehyde and an amine, as taught by Worrel. Baxter and Cherpeck merely teach how to make a reactant that may be used in the process of making the condensation product of Worrel and that this reactant is much more stable than that disclosed in Worrel.

5. Claims 97 and 98 are not rejected over the prior art of record. The prior art fails to teach or suggest fractionating the reaction mixture.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cephia D. Toomer/  
Primary Examiner  
Art Unit 1771

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